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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,959	07/30/1999	KEN HAYWARD	690-008568-U	1141

7590 05/18/2004

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 05/18/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/364,959

Applicant(s)

HAYWARD ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 02, 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murai (US Patent No. 5,592,307) in view of Ozaki et al (US Patent No. 5,933,478).

Concerning claims 1 and 5, Murai discloses an electronic assembly (Figs. 1 and 2) comprising a first image transfer device (2) for reading and transferring an image from a first medium, the first image transfer device including a reader (108) for reading the image on the first medium, and a display (150, Fig.3) for displaying an image transfer menu for effecting transfer of the image; and a computer (4) removably connected to the first image transfer device; wherein when the first image transfer device is not connected to the computer, the first image

Art Unit: 2626

transfer device has a first type of menu is displayed on the display device, and when the image transfer device is connected to the computer, the first transfer device has a second type display menu is available for display on the display device (Figs. 3, 46; Abstract; col. 4, line 66 – col. 5, line 67; col. 8, lines 47-63; col. 13, line 21 – col. 14, line 54; col. 66, line 20 – col. 69, line 28).

It is noted that when since the computer and the first transfer device 2 is connected through the personal cable 7 and the modem cable 8, the active state when the first transfer means connected to the computer is when the power of the computer is on, and when the power of the computer is off, the first transfer means is considered not connected to the computer since communications between them are not available.

Murai teaches that the computer and the first transfer device 2 exchange different information which are displayed on the display means 150 of the first transfer device. However, Murai does not directly teach that a first portion of the second type of the image transfer menu is stored in the computer. Ozaki discloses a data transfer system comprising a transfer device 100 with a display 102 (Fig.2) connected to a computer 110 (Fig.3) wherein when connected to the computer, the transfer device 100 displays different menu information which is stored in the computer 110 (Figs.30, 41A, 41B; col. Abstract; col. 19, lines 34-61; col. 24, line 27 – col. 25, line 23). It would have been obvious to one skilled in the art at the time the invention was made to combine the menu displaying in the transfer device 100 of Ozaki to the first transfer device (FAX 2) Murai since Murai also teaches that when the FAX 2 is connected to the PC 4, "The FAX 2 carries out, according to respective instructions from the PC 4, three operations, i.e. (a) transmission of PC data to the second FAX 114, (b) recording of PC data and (c) transmission of a telephone call to another telephone set which may be a telephone set

Art Unit: 2626

incorporated in the second FAX 114.” (col. 21, lines 35-42), and “the file name of the selected PC data is stored in the transmission-PC-data name buffer 322. If a positive judgment is made at Step S33, the control goes to Step S34 to display, on the display 116, a request to the user to input receiver data specifying a facsimile machine which is to receive the PC data, for example, the second FAX 114” (col. 24, lines 41-47). Thus the menu information displayed in the transfer device 100 of Ozaki is also for the transfer device FAX 2 in Murai.

Concerning claims 2-3, Murai further teaches that the first image transfer device is at least one of a copier, a fax machine or a printer (Figs.1, 2); and it includes a processor (200, Fig.4), for controlling operation of the device, a memory (202, 204, 206), a user interface (Fig.3).

Concerning claims 4-13, Murai further teaches that another portion of the second type of the image transfer menu is stored in the memory of the transfer device, the computer has software for enabling the display means to display the first or second type of menu wherein at least a portion of the second type of the image transfer menu is stored in the computer and the second type menu includes expanded features for operating the image transfer device; the first type of the menu includes a base set of different features which is commonly known for computer operations; the image transfer device is a fax machine and the extra feature is at least one of an extended phone log selection feature or adding a logo, a message or watermark; the image transfer device is adapted to transfer the image to a local/remote devices or printing device for printing the image; the computer is adapted for sending a polling signal (Figs. 3, 45, 46, 47; col. 4, line 66 – col. 5, line 67; col. 8, lines 47-63; col. 9, line 39 – col. 10, line 67; col. 13, line 21 – col. 14, line 54; col. 17, line 26 – col. 18, line 57; col. 21, lines 35-42; col. 24, lines 42-56; col. 51, lines 51, lines 1-64; col. 55, lines 51-67; col. 66, line 20 – col. 69, line 28).

Art Unit: 2626

Concerning claims 14-18, Murai discloses the subject matters as discussed in claims 1-13 above.

Claims 19-26 are method claims of apparatus claims 1-13. Claims 19-26 are rejected as claims 1-13.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ***

a. Nario et al (US Patent No. 5,914,713) discloses an application in which data fields stored on a computer are normally accessed and displayed in a facsimile machine.

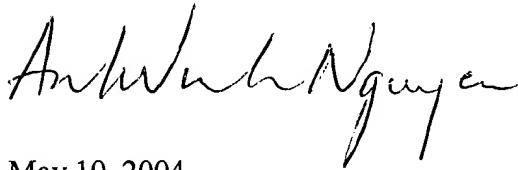
b. Tso (US Patent No. 6,072,598) teaches a method for enhancing usability of fax on small device which uses information contained within a transmittal file to render a version of the facsimile transmission image and displays it on the view screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

May 10, 2004